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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/336,462	06/18/1999	ROLF STEIGER	ICH-286	7675

25230 7590 10/02/2002

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EXAMINER

GRENDZYNSKI, MICHAEL E

ART UNIT	PAPER NUMBER
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1774

17

DATE MAILED: 10/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-17

<b>Office Action Summary</b>	<b>Application No.</b> 09/336,462	<b>Applicant(s)</b> STEIGER, ROLF	
	<b>Examiner</b> Michael E. Grendzynski	<b>Art Unit</b> 1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on 20 June 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5, 8, 9, 11-19 and 21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-3, 5, 8, 9, 11-19 and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3, 5, 8, 9, 11-19 and 21 are rejected under 35 U.S.C. 103(a) as being obvious over Brugger in view of Chen (US 5942335). Applicant claims a recording sheet comprising a support and at least one ink-receiving layer containing (1) a binder; (2) a porous inorganic oxide comprising colloidal aluminum oxide, colloidal aluminum oxide/hydroxide, or pseudoboehmite; at least one element of the rare earth metal series with atomic numbers 57 to 71; and (4) an aliphatic hydroxycarboxylic acid with more than 2 carbon atoms. Brugger discloses a recording sheet for ink jet printing comprising a substrate and an ink-receiving layer. *See* Abstract. The ink-receiving layer comprises a binder such as polyvinyl alcohol (*see* col. 4, ll 14-33), a porous inorganic oxide in the form of an colloidal alumina (pseudo boehmite), and from 0.04 to 4.2 mole percent of one or more elements of the rare earth metal series of the periodic system of the elements with atomic numbers 57 to 71 relative to  $Al_2O_3$ . *See* col. 3, ll 30-49. While disclosing that its ink-receptive layer comprising organic and inorganic hardening agents such as boric acid to improve physical properties of the layer, Brugger does not specifically disclose the use of a hydroxycarboxylic acid such as lactic acid. *See* col. 4, ll 40-63. Chen teaches that the addition of hardening agents such as acetic acid and lactic acid produces an ink-receiving layer of optimum toughness and controls ink-spreading. *See* col. 5, l 66 through col. 6, l 13. It would have been obvious to one of ordinary skill in the art at the time of the invention to use a hardening agent such as lactic acid, to

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provide the ink-receiving layer with optimum toughness ink-spreading control, as taught by Chen on col. 5, ll 65-68.

With specific regard to claim 8, “even though product-by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 227 USPQ 964, 966. Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). *See* MPEP §2113.

With specific regard to claim 13, Brugger discloses that its earth metal salt is lanthanum nitrate. *See* col. 9, ll 44-46.

With specific regard to claim 14, Brugger discloses that its layer may further comprise a cross linking agent. *See* col. 4, ll 40-47. In addition, the examiner considers the lactic acid a cross-linking agent. Furthermore, it is important to note that it is obvious to combine separately taught prior art ingredients (e.g., multiple cross-linking agents) which perform the same function--it is logical that they would produce the same effect and supplement each other. *In re Crockett*, 126 USPQ 186 (1960); *In re Kerkhoven*, 205 USPQ 1069 (1980).

With specific regard to claims 15 and 21, Brugger discloses that its ink-receiving layer comprises a filler such as silica. *See* col. 5, ll 1-10.

With specific regard to claim 16, Brugger discloses that its ink-receiving layer comprises surfactants. *See* col. 5, ll 51-64.

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With specific regard to claims 17 and 18, Brugger discloses the recording sheet may comprise several layers. *See* col. 6, ll 36-48.

With specific regard to claim 19, Brugger discloses that the thickness of its ink-receiving layer comprises a thickness of 0.5 to 100  $\mu\text{m}$ . *See* col. 6, ll 32-34.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. *See* MPEP § 706.02(l)(1) and § 706.02(l)(2).

3. Claim 20 is rejected under 35 U.S.C. 103(a) as being obvious over Brugger in view of Chen, as applied to claims 1-3, 5, 8, 9, 11-19 and 21, above, in view of either (1) Floegel (US 6284339) or Uemura (US 6153305), or (2) Kasahara. Brugger clearly contemplates coating its ink-receptive layer on both sides of the substrate. *See* col. 5, ll 17-18. This practice reduces the curling of the medium; consequently, meet applicant's definition of an anti-curl layer. *See* Floegel at col. 4, ll 22-26 and Uemura at col. 11, ll 46-48. In addition, the use of antistatic and anti-curl layers is well known in the art; consequently their use would be obvious. *See* Kasahara, col. 15, ll 60-64.

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***Conclusion***

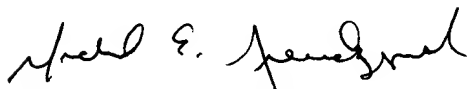
4. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

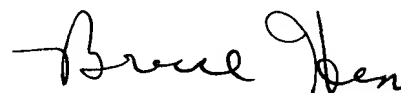
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael E. Grendzynski whose telephone number is 703-305-0593. The examiner can normally be reached on weekdays, from 9:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703-308-0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-5408 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.



Michael E. Grendzynski  
Assistant Examiner  
September 13, 2002



BRUCE H. HESS  
PRIMARY EXAMINER